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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225722
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

STEVE JACKSON GAMES INCORPORATED
Opposer,

v.

INXILE ENTERTAINMENT, INC.
Applicant.

Opposition No. 91225722
Serial No. 86/702,458

OPPOSER'S TRIAL BRIEF

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III. INTRODUCTION

Opposer, Steve Jackson Games Incorporated, is a pillar of the gaming community. Gaming and hobby stores have sold Opposer's games for decades, and its products can be purchased from national chains as well. This proceeding involves one of Opposer's longest-running properties, AUTODUEL, with products sold continuously since 1982. Applicant, inXile Entertainment, Inc. ("Applicant"), after learning that Opposer had no pending filing for its AUTODUEL mark, rushed to the USPTO in an attempt to slip under the radar and preclude Opposer from registering its AUTODUEL mark or using the mark for computer games. Applicant chose this approach in spite of (or perhaps *because of*) the fact that Applicant knew Opposer had previously licensed its AUTODUEL mark for computer games.

Applicant improperly seeks to register "AUTODUEL" for "Providing online downloadable computer and video game programs; Interactive video game programs." It is undisputed that in the wake of Applicant's filing of Application Serial No. 86702458, both the gaming media and consumers actually confused Applicant's filing as being affiliated with Opposer and incorrectly thought that Applicant's AUTODUEL game would be related to Opposer's earlier-released 1985 video game, AUTODUEL, and Opposer's AUTODUEL game products.

In knowing violation of Opposer's common law trademark rights, Applicant now seeks to eventually develop and offer a *post-apocalyptic vehicle combat game* under the AUTODUEL mark. Since 1982, Opposer has continuously used its AUTODUEL mark in connection with a variety of *post-apocalyptic vehicle combat games*, supplements, and accessories. Today, consumers can buy from Opposer's Warehouse23.com and the third party DriveThruRPG.com online stores no less than 50 different AUTODUEL products, from the GURPS® Autoduel™ role-playing world book and AADA Road Atlas game supplements, to the Autoduel™ America maps and the Autoduel™ Quarterly game supplements. The similarities between Opposer's actual use and Applicant's proposed use are glaring, and that is without even considering that Opposer has licensed the AUTODUEL mark for a well-known *post-apocalyptic computer role playing game* with the main feature being *vehicle combat* (again, a use that Applicant had in mind when filing its application).

Applicant has unsuccessfully argued that because the products currently sold by Opposer are digital copies of these game materials, that somehow the ongoing sales of these products confers no rights upon Opposer. The Board has rejected this argument, denying Applicant's abandonment defense, and recognizing that Opposer has maintained rights in the AUTODUEL mark through continued use of the trademarks in commerce. Based on the evidence submitted by Applicant in during the trial period, the Board should expect Applicant to attempt these unsuccessful arguments again. This is perhaps unsurprising, since the marks at issue in this case are identical, the goods, trade channels, and conditions of sale are highly related, and the mere filing of Applicant's application undisputedly resulted in actual consumer confusion. This is an easy case—the likelihood of confusion that would result from Applicant's proposed use of AUTODUEL is unavoidable.

Further, Applicant made it abundantly clear during discovery that it had no *bona fide* intent as of its filing date for AUTODUEL for "Providing online downloadable computer and video game programs; Interactive video game programs," unless one considers an intent to free ride on another's mark as *bona fide*. Applicant has produced no documents that pre-date the filing. Applicant had no product plans, business plans, or research at the time of filing. As of the time Applicant submitted its trial testimony, two years and nine months after filing the application, Applicant still had only vague ideas for a potential computer/video game. Applicant merely liked the name, largely because of Opposer's AUTODUEL computer game, and wanted to keep anyone else from registering it. In other words, Applicant opportunistically sought to reserve potential use of the AUTODUEL mark for when it might, sometime in the future, decide to develop a game with which to use the mark. Applicant cannot establish a *bona fide* intent at the time of filing.

IV. DESCRIPTION OF RECORD

The evidence of record in this proceeding consists of the following:

- Testimonial Declaration of Phil Reed, CEO of Opposer Steve Jackson Games, Incorporated, including the exhibits submitted therewith, pertaining to, *inter alia*, (a) Opposer's adoption and use of the AUTODUEL mark in connection with a wide range of gaming products; (b) Opposer's business, products, and trade channels; (c) actual confusion; and (d) Opposer's policing of its mark (Confidential version at 25 TTABVUE; Public version at 26 TTABVUE)
- Opposer's Notice of Reliance on Internet Materials, including the exhibits submitted therewith, demonstrating numerous instances of actual confusion (27 TTABVUE)
- Opposer's Notice of Reliance on Discovery Responses, including the exhibits submitted therewith (28 TTABVUE)
- Opposer's Notice of Reliance on Official Records, including the exhibits submitted therewith (29 TTABVUE)
- Opposer's Notice of Reliance on Discovery Depositions, including the exhibits submitted therewith (Confidential version at 30 TTABVUE; Public version at 31 TTABVUE)
- Applicant's Notice of Reliance on Official Records, including the exhibits submitted therewith (33 TTABVUE)
- Applicant's Notice of Reliance on Discovery Depositions, including the exhibits submitted therewith (Confidential version at 35 TTABVUE; Public version at 34 TTABVUE)
- Testimonial Deposition of Brian Fargo, CEO of Applicant inXile Entertainment, Inc., including the exhibits submitted therewith (Confidential version at 37 TTABVUE; Public version at 36 TTABVUE)
- Applicant's Cross-Examination of Phil Reed, including the exhibits submitted therewith (Confidential version at 39 TTABVUE; Public version at 38 TTABVUE)

V. STATEMENT OF ISSUES

1. Whether Applicant's had the requisite *bona fide* intent to use the AUTODUEL mark at the time it filed its application;

2. Whether Opposer's priority in its use of the AUTODUEL mark dates back to 1982, or to some other date between 1982 and 2005; and

3. Whether Applicant's proposed AUTODUEL mark so resembles Opposer's AUTODUEL Mark as to be likely, if registered in connection with "Providing online downloadable computer and video game programs; Interactive video game programs," to cause confusion, or to cause mistake, or to deceive.¹

VI. RECITATION OF FACTS

A. Steve Jackson Games and Adoption of the AUTODUEL Mark.

Opposer is a publisher of games, books, and gaming-related magazines. 25 TTABVUE 2 (¶ 3). Since 1980, Opposer has published over 100 different titles, including board games, role playing games, card games, dice games, and war games, as well as supplements for its games (materials that add new features, rules, settings, etc. for use with the base games) and a wide range of accessories, including miniatures, plush figures, and clothing. *Id.* Opposer also offers mobile apps for use with its tabletop games, as well as stand-alone online, computer, and mobile games. *Id.*

Steve Jackson Games first released an AUTODUEL product in the United States in 1982 when it began selling miniature figures bearing the mark AUTODUEL! for its Car Wars™ board game. *Id.* at ¶ 4. Based on this use, Opposer's predecessor (Steven G. Jackson d.b.a. Steve Jackson Games) registered the mark AUTODUEL! with the USPTO in connection with "Miniature Figures for Use with a Parlour Game

¹ The Board has already determined that Opposer has standing (18 TTABVUE 2), and that Opposer has rights in the AUTODUEL Mark in connection with digital gaming products dating back to 2005 (*id.* at 3). Accordingly, the Board entered summary judgment on Applicant's abandonment defense, while also striking Applicant's unsupported unclean hands defense. *Id.* at 5.

Sold Separately”, Registration No. 1,293,028, issued September 4, 1984. *Id.* The registration was assigned to Opposer as of October 1, 1984. Opposer’s Reg. No. 1,293,028 was eventually cancelled by the USPTO as of June 11, 2005, after Opposer failed to maintain the registration despite continued use of the AUTODUEL mark. *Id.*

Car Wars™ is a vehicular combat board game where players build vehicles with weapons, armor, and more, and then engage in combat in a post-apocalyptic setting. *Id.* at ¶ 5. Opposer’s Car Wars™ board game is on its 5th Edition, with a 6th Edition announced and under playtesting, and with a Kickstarter crowdfunding campaign planned for 2018. *Id.* Opposer has released a large number of supplements and accessories for the Car Wars game, including a stand-alone Car Wars™ The Card Game and a Kickstarter campaign and late 2015 product launch for Car Wars Arenas, a new release of arena maps from prior Car Wars supplements. *Id.*

Like the AUTODUEL miniature figures, a number of Opposer’s AUTODUEL products are supplements for its Car Wars™ game, and all of its AUTODUEL products involve vehicular combat and inhabit the same post-apocalyptic setting fifty years in the future. *Id.* at ¶ 6. For instance, Opposer’s Autoduel™ Quarterly provides campaign seeds, scenarios, vehicles, mock advertisements, new weapons and accessories, and fiction relating to the Car Wars/Autoduel world. *Id.*

Opposer is also the creator of the Generic Universal RolePlaying System, or GURPS. GURPS® is a tabletop role-playing game system designed to allow for play in any game setting. *Id.* at ¶ 7. GURPS® Autoduel™ is a role-playing “worldbook” that provides gamers with the rules, background, setting, and details necessary to conduct role-playing games using the GURPS system and set in the post-apocalyptic Car Wars setting. Several of the AUTODUEL products sold by Opposer are supplements for both Car Wars™ and GURPS® Autoduel™. *Id.*

B. Goods and Services Offered Under the AUTODUEL Mark.

Opposer has released a wide range of titles under the AUTODUEL brand, as well as additional supplements which bear the AUTODUEL mark. The chart below summarizes these products, along with physical and digital release dates:

<u>Product</u>	<u>Description</u>	<u>Initial Physical Release</u>	<u>Initial Digital Release</u>	<u>Exhibit (25 TTABVUE) & Bates Nos.</u>
Autoduel!® miniatures	miniature figurines of vehicles; registration has since expired	1982	n/a	<u>Exhibit 2</u> SJG002015-2016
Autoduel™ Champions	role-playing game in Car Wars™ setting with superheroes from Champions game, the latter of which was licensed	1983	n/a	<u>Exhibit 3</u> SJG001092
Autoduel™ Quarterly	quarterly supplement for Car Wars, and later, GURPS® Autoduel™, featuring campaign seeds, scenarios, vehicles, mock advertisements, new weapons and accessories, and fiction relating to Car Wars world	1983-1993 (40 issues)	2005	<u>Exhibit 4</u> SJG002018
Autoduel™ Play-By-Mail	play-by-mail version of Car Wars, operated under license by Prometheus Games	1984	n/a	<u>Exhibit 5</u> SJG000254 (ad for service)
Autoduel™ video game	vehicular combat video game, based on Car Wars, released by Origin Systems under license from Opposer	1985-1988 (multiple platforms)	n/a	<u>Exhibit 6</u> SJG000239-240 (game cover and ad shown)
GURPS® Autoduel™ (1 st Edition)	role-playing game in the same universe as Car Wars, using Opposer's GURPS® role-playing game system	1986	2017	<u>Exhibit 7</u> SJG001095
AADA™ Road Atlas	game supplement for Car Wars and GURPS Autoduel	1986-1991 (7 volumes)	2014	<u>Exhibit 8</u> SJG001912, 21, 30, 39, 48, 57, 66
GURPS® Autoduel™ : Car Warriors	game supplement for GURPS Autoduel	1987	n/a	<u>Exhibit 9</u> SJG001099
Zombietown USA	game supplement for GURPS Autoduel	1988	2006	<u>Exhibit 10</u> SJG001103
Autoduel™ America map	two full-color maps for use with Car Wars and GURPS Autoduel	1989	2013	<u>Exhibit 11</u> SJG001981
Autoduel™ Online	announced online video game under	n/a	n/a	n/a

	development by licensee VictorMaxx in 1995-1996, but ultimately cancelled			
GURPS® Autoduel™ (2 nd Edition)	new edition of role-playing game in the same universe as Car Wars, using Opposer's GURPS role-playing game system	1996/1997	2008	<u>Exhibit 12</u> SJG000919

25 TTABVUE 3-5 (¶ 8 and Exs. 2-12). Opposer's marks and designations incorporating AUTODUEL, including without limitation, AUTODUEL, AUTODUEL QUARTERLY, GURPS AUTODUEL, and AUTODUEL AMERICA, are collectively referred to herein as the "AUTODUEL Mark."

C. Distribution and Sales of the AUTODUEL Goods.

Opposer sold its physical AUTODUEL gaming products throughout the U.S. every year from 1982 until 2012, with the exception 1994-1995, when no records were available. *Id.* at ¶¶ 8, 10.² The period from 1994-1995 represents time before the announcement of a newly updated GURPS® Autoduel™ Second Edition in 1996 and release in 1997. *Id.* at ¶ 10. It is a common practice of Opposer to temporarily list products as out-of-stock between different editions so that stock of an earlier edition can be cleared from its warehouse and from retailers' stock before a new edition is released. *Id.* Opposer has sold well over 350,000 AUTODUEL-branded physical game products. *Id.* at ¶ 13. The suggested retail price for these products ranged from \$2.50 for early issues of Autoduel Quarterly to \$19.95 for GURPS Autoduel. Opposer continued to sell physical AUTODUEL-branded game products until 2012, when it sold its remaining stock. *Id.*

Opposer has continuously sold digital gaming products under the AUTODUEL Mark in the United States since 2005, and has expanded the collection of products bearing the AUTODUEL Mark over time with digital product releases of Autoduel™ Quarterly (2005), Zombietown USA supplement

² The Testimonial Declaration of Phil Reed contains numerous additional sales-related details, as well as exhibits showing sales figures from 1983 to the present, for Opposer's AUTODUEL products. *See* 25 TTABVUE 3-9 (¶¶ 8-25 and Exs. 13-15).

(2006), GURPS® Autoduel™ Classic (2008), Autoduel™ America maps (2013), AADA Road Atlases (2014), and GURPS® Autoduel™ Classic, First Edition (2017). *Id.* at ¶ 22. Today, consumers can visit Opposer's Warehouse23.com online retail store, or the third party retailer DriveThruRPG.com and purchase no less than 50 different products³ bearing the AUTODUEL Mark. *Id.* at ¶ 23; 39 TTABVUE 43:19-45:13. Consumers who purchase digital products from Warehouse23.com benefit not only by saving shelf space and not needing to worry about damage as compared to physical copies, but also get the flexibility of being able to re-download purchased files and print a copy of the game or game supplement for personal use. 25 TTABVUE 9 (¶ 23).

From 2005 to 2017, Opposer sold over 8000 AUTODUEL-branded digital game products (over \$27,000 in sales), including over 4500 during the years 2014-2017 (over \$15,000 in sales). *Id.* at ¶ 16. These figures include sales from the US-based Warehouse23.com to customers both in the United States and in other countries. Approximately 75% of the sales are to customers in the United States. *Id.*

D. Licensing of the AUTODUEL Mark for Computer Games

Opposer has licensed use of the AUTODUEL Mark for computer games. The most well-known license was to Origin Systems, which originally released an AUTODUEL computer game in 1985, with subsequent releases on additional platforms from 1985-1988. *Id.* at ¶ 18. The AUTODUEL computer game was set in the same post-apocalyptic setting and had the same vehicular combat features as the physical AUTODUEL gaming products.⁴ *Id.* Opposer received royalties from this license through at least September 1992. *Id.*

³ Exhibits 18-30 of the Testimonial Declaration of Phil Reed contain captures of Warehouse23.com product listings for currently-available AUTODUEL products.

⁴ Opposer does not have detailed sales figures available for the AUTODUEL computer game because the distribution was primarily handled by licensee Origin Systems. 25 TTABVUE 7 (¶ 16). Opposer's sales through its own mail-order service can be found in 25 TTABVUE at Exhibit 13 (SJG001988).

Opposer subsequently licensed the AUTODUEL Mark for computer games to a company called VictorMaxx in 1995-1996, and a prototype game was created, but VictorMaxx filed for bankruptcy before it was able to release its AUTODUEL computer game. *Id.* at ¶ 20. Opposer still receives potential licensing inquiries and continues to have interest in licensing the AUTODUEL mark for the development of a computer game based on the AUTODUEL/Car Wars world, [REDACTED] *Id.* at ¶ 21; 39 TTABVue at 32:15-33:17, 79:18-80:4.

E. Availability and Continued Use of AUTODUEL Products.

From 1982 to the present, with the exception of the year 1994 for which Opposer has no records, consumers have been able to access and/or acquire AUTODUEL-branded materials from Opposer or its predecessor. 25 TTABVue 10 (¶ 28). Opposer's Autoduel™ Quarterly game supplements have had the widest availability over the years in various forms, including print (1983-1993), HTML format at sjgames.com (1995-2006), and digital purchase and download (2005-present). *Id.* at ¶ 25. Opposer's GURPS® Autoduel™ products have been available from 1986 to the present, with two exceptions: (a) 1990-1995 before the release of the Second Edition in 1996/97; and (b) 2004-2007, before the release of GURPS® Autoduel™ Classic, the digital version of the Second Edition, in 2008. *Id.* at ¶ 27. Opposer has never intended, planned, or even considered permanently stopping use of the AUTODUEL Mark in connection with its game products, and as detailed above, is still selling AUTODUEL-branded products today. *Id.* at ¶ 29.

Consumers who purchased AUTODUEL game supplements in the 1980s, 1990s, or 2000s, or over the last 8 years can still use those products to play Car Wars® and GURPS® Autoduel™ today. *Id.* at ¶ 28. Consumers who have learned of Car Wars and GURPS more recently can purchase AUTODUEL-branded digital games and supplements to discover the AUTODUEL world of vehicular combat and sit down with friends to play a new AUTODUEL game today. *Id.*

F. Applicant's Application to Register AUTODUEL and Aftermath.

Before filing the Application that is the subject of this proceeding, Applicant's CEO, Brian Fargo, was aware that Opposer had previously enforced its rights in the AUTODUEL Mark. Specifically, Mr.

Fargo was aware of Opposer's prior dispute with Big Boat Interactive/Pixelbionic, and Opposer's claimed rights in the AUTODUEL mark at least as far back as 2013. 30 TTABVUE 33, 64 (Ex. 52 at 93:20-94:24, 177:1-177:10). In fact, Maxx Kaufman, a founder of Pixelbionic, was also working for Applicant at the same time that Pixelbionic was dealing with Opposer's demand letter and opposition proceeding. 37 TTABVUE 3 (§ 6). Upon learning that Opposer had allowed an application to register the AUTODUEL Mark to become abandoned, Mr. Fargo instructed that Applicant's AUTODUEL application be filed quickly so that no one else could file first. 30 TTABVUE 31-32 (Ex. 52 at 91:17-92:9).

Applicant filed its application to register AUTODUEL in connection with "Providing online downloadable computer and video game programs; Interactive video game programs" on July 23, 2015. Opposer has no business relationship with Applicant, and has never authorized or otherwise permitted Applicant to use the AUTODUEL Mark. 25 TTABVUE 15 (§ 48). Mr. Fargo understood that Applicant's choice of AUTODUEL carried with it some inherent value as a result of Opposer's use of the AUTODUEL mark: "Well, I thought it was a great name and I knew there was a computer game before that. So it certainly wouldn't hurt. . . . Whenever there's any requisition value for names, I find it helps to establish yourself in a crowded marketplace." 30 TTABVUE 32 (Ex. 52 at 92:10-92:23). Mr. Fargo further admits that his proposed AUTODUEL game would be "based on" Opposer's prior AUTODUEL game. *Id.* at 70-71 (Ex. 52 at 183:19-184:8).

Opposer learned of Applicant's application to register AUTODUEL after several articles were published on gaming news sites reporting on the discovery of the application. *Id.* at 13 (§ 39). Several of these articles used images from the 1985 AUTODUEL computer game, made assumptions that Applicant would be rebooting the 1985 AUTODUEL computer game, referenced Steve Jackson Games, and/or referenced Opposer's CAR WARS game. *Id.* Ultimately, Opposer filed this proceeding to oppose registration of the AUTODUEL mark by Applicant.

G. Applicant's Proposed Use of AUTODUEL.

Applicant has submitted into the record a total of nine (9) documents (a total of 42 pages) relating to Applicant's selection, planned use/advertising, channels of trade, target customers, business research,

and steps taken toward offering goods under the AUTODUEL mark. *See* 37 TTABVUE 10-61 (Exs. 54-62). The earliest of these documents is dated October 22, 2015, almost three months after the filing of its application, and pertains to a media inquiry that resulted from the discovery that Applicant had filed its AUTODUEL application. *Id.* at 10-12 (Ex. 54). The remaining documents consist of brief correspondence (*id.* at Exs. 55-59, 62), a pitch from an outside studio that wanted to work with Applicant (*id.* at ¶ 19, Ex. 60), and an internal “quick pitch” from an employee that was “just a design exercise for myself” (*id.* at Ex. 61).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Mr. Fargo’s testimonial declaration provides a few additional details about its alleged AUTODUEL project, namely that sometime after February 2017, two individuals were assigned to the product and that Applicant is doing undescribed “continuing work” on design/concept details. *Id.* at 7 (¶ 22).

The record also indicates that Applicant’s proposed AUTODUEL game is vehicular combat game in a post-apocalyptic setting (28 TTABVUE 7 (Ex. 43, Response to Interrogatory No. 6); 30 TTABVUE 153 (Ex. 53 at 96:16-97:11)) and that Applicant proposes to sell its AUTODUEL game through mobile app stores and through Steam (28 TTABVUE 10 (Ex. 43, Response to Interrogatory No. 12); 37 TTABVUE 8 (¶ 25)).

H. Trade Channels and Licensing Between Tabletop and Video Games.

Opposer sells a number of different game products in addition to its AUTODUEL-branded products, including various licensed products. 25 TTABVUE 10-11 (¶ 30). For example, Opposer

previously released GURPS® Myth, which was based on the Myth computer game series that was released by the publisher Bungie. Opposer also previously released GURPS® Alpha Centauri, which was based on the computer game Sid Meier's Alpha Centauri released by the publisher Electronic Arts. *Id.*

Opposer has released and currently has available for purchase or download a number of computer software and video game products, including mobile games Dino Hunt® Dice and Zombie Dice®, mobile apps for use with its board game products, including Ogre® War Room and Munchkin® Level Counter, and online games Frag®, Warehouse 23®, and UltraCorps® (acquired from Microsoft). *Id.* at 11 (¶ 31). The Dino Hunt® Dice game is available for free from the Apple App Store. The Ogre® War Room app is available for free, and the Munchkin® Level Counter app is available for \$4.99, both from the Apple App Store and the Google Play store. *Id.* The Zombie Dice® game is available for free from the Apple App Store and the Microsoft/Windows Phone store. *Id.*

Opposer worked with developer Auroch Digital to produce a computer game, Ogre®, based on its classic tank warfare board game. *Id.* at 11 (¶ 32). The game was announced July 26, 2016, and released for purchase on October 5, 2017, to positive reviews. *Id.* The game is distributed through the Steam digital distribution platform, and can be played on PC and Mac computers. *Id.* This game is the second computer game adaptation of Ogre. *Id.* The original computer game was released in 1986 by Origin Systems. *Id.*

Opposer is working with developer Asmodee Digital to produce a digital adaptation of its Munchkin® board game as well. *Id.* at 11-12 (¶ 33). The game was announced on October 27, 2017, and planned for release in 2018. *Id.*

Steve Jackson Games has representatives appear at a wide range of industry conventions, including those that are open to the public and attended by companies in both the board game and computer/video game industry, such as RTX, Pax Prime, Pax East, and Pax South. *Id.* at 12 (¶ 34).

Opposer's products are offered or sold through a wide variety of outlets. *Id.* at 12 (¶ 35). Its physical game products are sold at local hobby/game stores, national retail chains (including Target, Wal-Mart, and Walgreens), and a wide range of online retailers (including Amazon.com, Target.com, Walmart.com, online hobby/game stores, DriveThruRPG.com, and its own Warehouse23.com online

retail store). *Id.*; 39 TTABVUE 43:19-45:13. Opposer's mobile games and applications, referenced above in Paragraph 31, are offered or sold through the Apple App Store, the Google Play store, the Microsoft/Windows Phone store. 25 TTABVUE 12 (§ 37). Opposer also has two online games, Frag and Ultracorps, available for play through a web browser. *Id.*

Opposer has successfully funded twelve different game/supplement releases through the Kickstarter crowdfunding platform – Ogre Designer's Edition, Car Wars Classic Arenas, Dungeon Fantasy Role Playing Game Powered by GURPS, Ogre Miniatures Set 1, Munchkin Shakespeare, Munchkin Special Delivery, Ogrezine, Conspiracy Theory, Munchkin Holiday Grab Boxes, Munchkin Starfinder, Ogre Miniatures Set 2, and most recently, Triplanetary. *Id.* at 12-13 (§ 38).

I. Actual Confusion Caused by Applicant's AUTODUEL Application.

Opposer learned of Applicant's application to register the AUTODUEL mark after several articles were published on gaming news sites reporting on the discovery of the application. 25 TTABVUE 13 (§ 39). The confusion started when the account for game news site RPG Codex tweeted on October 22, 2015: "Hell yes" and posted a screenshot of the TSDR page for Applicant's application. *See* 27 TTABVUE 6 (Ex. 33). The same day, Applicant's CEO, Brian Fargo, responded: "Once again the Codex is the first on the scene..." *Id.* at 8 (Ex. 34). The responses to Fargo's tweet included the following: (1) "@BrianFargo any relation to @SJGames Autoduel?"; (2) "@ryannims @BrianFargo @SJGames Would think so. Another company tried to release an unrelated game and they had to change the name."; and (3) "@mattaui with the new edition of Car Wars in progress, now's a great time for a digital version! @BrianFargo @SJGames"; as well as numerous other comments reminiscing about the 1985 AUTODUEL game by Origin Systems under license from Opposer. *Id.* at 8-10 (Ex. 34).

The exchange between RPG Codex and Applicant's CEO triggered a flurry of articles and consumer comments on a number of gaming websites relating Applicant's proposed use of AUTODUEL. Several of these articles displayed images from Opposer's games (*see, e.g.*, 27 TTABVUE 11-57 (Exs. 35-42), indicating a belief of sponsorship or association between Applicant's application and Opposer and its AUTODUEL mark. *See* 25 TTABVUE 13, 16, and 121 (§ 39, and Exs. 6 (AUTODUEL video game

box) and 32 (Car Wars Deluxe Edition box)). Section VII(C)(11) below identifies a number of specific statements and comments indicating actual confusion as to an association or connection between Applicant's proposed AUTODUEL game and Opposer and its AUTODUEL Mark.

VII. ARGUMENT

A. Applicant Had No *Bona Fide* Intent to Use the AUTODUEL Mark At Filing.

Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), allows trademark applications to be filed based on a bona fide intention to use the mark in commerce. Such a filing must be “under circumstances showing good faith.” 15 U.S.C. § 1051(b)(1). In other words, Applicant must be able to present objective evidence of its *bona fide* intent; merely saying that Applicant has such an intention is insufficient. *See Lane Ltd. v. Jackson International Trading Co.*, 33 U.S.P.Q.2d 1351, 1355 (TTAB 1994). Applicant cannot meet its burden to present objective evidence of its *bona fide* intent at the time of filing.

Applicant has submitted into evidence a total of nine documents relating to Applicant's selection, planned use/advertising, channels of trade, target customers, business research, and steps taken toward offering goods under the AUTODUEL mark. *See* 37 TTABVue 10-61 (Exs. 54-62). The earliest of these documents is dated October 22, 2015, almost three months after the filing of its application, and pertains to a media inquiry that resulted from the discovery that Applicant had filed its AUTODUEL application and subsequent confusion as to an association with Opposer's AUTODUEL Mark and licensed video game. *Id.* at 10-12 (Ex. 54). The remaining documents consist of brief correspondence (*id.* at Exs. 55-59, 62), a pitch from an outside studio that wanted to work with Applicant (*id.* at ¶ 19, Ex. 60), and an internal “quick pitch” from an employee that was “just a design exercise for myself” (*id.* at Ex. 61). These documents demonstrate that people, both inside and outside the company, had become aware of Applicant's filing, but do not evidence a *bona fide* intent to use the mark at the time of filing.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Although it has been almost two years since his deposition in this case, Mr. Fargo's testimonial declaration provides scant additional details about its alleged AUTODUEL project, namely that sometime after February 2017, two individuals were assigned to the product and that Applicant is doing undescribed "continuing work" on design/concept details. *Id.* at 7 (§ 22). Applicant's actions indicate that it was aware of Opposer's challenge to its alleged *bona fide* intent, but not that it had such intent at the time of filing.

Applicant has not used the AUTODUEL mark in commerce, and Applicant's deposition testimony and trial submissions indicate that its development plans and business strategy for marketing products under the mark did not exist at filing and are still in their infancy today, over three years after filing its application. Without a sufficient explanation, "the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (TTAB 1993). The true explanation here is that Mr. Fargo instructed that Applicant's AUTODUEL application be filed quickly so that no one else could file first. 30 TTABVue 31-32 (Ex. 52 at 91:17-92:9).

Considering the entire circumstances discussed above, Applicant's filing of Serial No. 86702458 was made: (a) without a *bona fide* intention to use the mark in commerce; and (b) merely to reserve the mark and exclude others from registering AUTODUEL. Thus, Opposer is entitled to judgment on its lack of *bona fide* intent claim. If the Board finds that the evidence presented by Applicant is sufficient to demonstrate a *bona fide* intent, it is only because Applicant had a *bona fide* intent to take advantage of the goodwill in Opposer's AUTODUEL Mark to market its own AUTODUEL computer game.

B. Opposer Has Priority in the AUTODUEL Mark.

1. *Opposer's AUTODUEL Mark Is Distinctive.*

Almost 35 years ago, Opposer coined the AUTODUEL Mark for its miniature figures, and continues to use the mark today. A review of any dictionary will show that “Autoduel” is not a word in the English language. Moreover, USPTO action on Opposer’s prior applications for the AUTODUEL Mark indicate that the mark is inherently distinctive. Opposer previously registered the mark AUTODUEL! on the Principal Register for “Miniature Figures for Use with a Parlour Game Sold Separately”. 25 TTABVUE 2 (¶ 4 and Ex. 1). Opposer has further filed two applications to register the AUTODUEL Mark. The first, Serial No. 85940537, lapsed due to Opposer’s inadvertent failure to respond to an office action, but the USPTO never raised lack of distinctiveness as an issue. *See* 29 TTABVUE 37-41 (Ex. 47). The second, Serial No. 86806802, covering the same mark and goods, is suspended pending Applicant’s opposed application with no other issues raised in prosecution. *See id.* at 9 (Ex. 46). Finally, the opposed application, Serial No. 86702458, was approved for publication on the Principal Register for game products, in this case “Providing online downloadable computer and video game programs; Interactive video game programs.” The evidence is clear that AUTODUEL is inherently distinctive. Further, the evidence discussed in detail below in Section (VII)(C)(11) demonstrates extensive actual confusion, and thus the AUTODUEL Mark does in fact distinguish Opposer and its goods in the market.

2. *Opposer Has Continuously Used the AUTODUEL Mark in Commerce Nationwide For Over 35 Years.*

As discussed above in Section IV(A)-(E), Opposer began selling gaming products under the AUTODUEL Mark in 1982, and has done so in every year except 1994-95, when Opposer’s GURPS® Autoduel™ product was out of stock between editions. *See* 25 TTABVUE 2-10 (¶¶ 4, 8-28). Opposer has also continuously sold digital gaming products under the AUTODUEL Mark since 2005. *See id.* at 6-7, 9 (¶¶ 14-16, 22-23). Today, consumers purchase AUTODUEL role-playing games, maps, and other game

supplements from Opposer's Warehouse23.com online store as well as the third-party retailer DriveThruRPG.com. *Id.* at 9 (¶ 23); 39 TTABVUE 43:19-45:13.

Opposer has submitted into the trial record extensive testimony and documentation to establish its continuous use of the AUTODUEL Mark for over 35 years. In every year from 1982 until the present, with the exception of 1994 for which Opposer has no records, consumers have been able to access and/or acquire AUTODUEL branded materials from Opposer or its predecessor. 25 TTABVUE 10 (¶ 28.) Consumers who purchased AUTODUEL game supplements in the 1980s, 1990s, or 2000s, or over the last 8 years can still use those products to play Car Wars® and GURPS® Autoduel™ today. Consumers who have learned of Car Wars and GURPS more recently can purchase AUTODUEL-branded digital games and supplements to discover the AUTODUEL world of vehicular combat and sit down with friends to play a new AUTODUEL game today. In other words, Opposer has long-standing and extensive rights in the AUTODUEL Mark in connection with gaming products.

Finally, Opposer may have inadvertently allowed itself to be in a position today of owning no federal trademark registration for its AUTODUEL Mark, but as the Board has already found, Opposer has not abandoned its AUTODUEL Mark. Ultimately, Opposer's common law rights in the AUTODUEL Mark are well-established, and Applicant's arguments to the contrary are destined to fail.

C. Applicant's Proposed Use of AUTODUEL Is Likely To Result In Consumer Confusion.

In determining whether there is a likelihood of confusion between two marks, the Board considers the factors identified in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and "any one of the factors may control a particular case." *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997). As demonstrated by the analysis below, every relevant factor favors Opposer.

1. Applicant's Proposed Mark AUTODUEL is Identical to Opposer's Mark.

Applicant's proposed mark AUTODUEL is identical to the AUTODUEL Mark used by Opposer for almost 35 years. Because the marks here are identical, the first factor not only weighs heavily in favor

of a finding of likelihood of confusion, but also reduces the degree of similarity between the goods that is required to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687, 1688 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (TTAB 2002).

Even considering that Opposer uses the separate registered mark GURPS and the common descriptive terms “Quarterly” and “America” in connection with certain AUTODUEL products, it is clear that the AUTODUEL Mark is the dominant, distinguishing portion of these uses. Because of the strong similarity between Applicant’s proposed mark and Opposer’s AUTODUEL Mark, the first factor weighs heavily in favor of Opposer.

2. *Applicant’s Proposed Goods are Very Closely Related to Opposer’s Current Goods, and Identical to Opposer’s Past Goods Offered under Opposer’s Mark.*

To support a finding of likelihood of confusion, it is sufficient that the respective goods are related or marketed in a manner that could give rise to the mistaken belief that they originate from a common source. *See Hilson Research, Inc. v. Soc’y for Human Res. Mgmt.*, 27 U.S.P.Q.2d 1423, 1432 (TTAB 1993); *In re Int’l Tel. & Tel. Corp.*, 197 U.S.P.Q. 910, 911 (TTAB 1978). Here, the evidence is overwhelming that the products are related and would be marketed in a manner that creates confusion. First, both Opposer’s AUTODUEL products and Applicant’s proposed AUTODUEL game are vehicular combat games in a post-apocalyptic setting. *See* 25 TTABVUE 2-5 (¶¶ 5-8, 18); 28 TTABVUE 7 (Ex. 43, Response to Interrogatory No. 6); *see also* 30 TTABVUE 153 (Ex. 53 at 96:16-97:11). Moreover, Opposer has previously licensed the AUTODUEL Mark for video games and computer games. 25 TTABVUE 8 (¶¶ 18-20). Further, whether or not Applicant’s AUTODUEL game is a role-playing game, both parties are known for releasing this role-playing games. *See id.* at ¶ 6; 30 TTABVUE 23 (Ex. 52 at 36:20-37:3).

Moreover, it is common in the industry for intellectual property, including trademarks, to be licensed from makers of video games to makers of tabletop games, and vice versa. For instance, Opposer previously released a GURPS® Myth game and a GURPS® Alpha Centauri based on licenses from the

makers of the “Myth” and “Sid Meier’s Alpha Centauri” computer games. 25 TTABVUE 10-11 (¶ 30). On the flip side, Applicant recently released Torment: Tides of Numenera. [REDACTED] 37 TTABVUE 7 (¶ 22); 30 TTABVUE 147-48 (Ex. 53 at 83:21-84:11). It is not surprising, then, that the Board has previously found that “board games” and “online and electronic games” are highly related goods, noting among other things evidence of websites featuring advertisements for electronic versions of popular board games. *In re J.G. Julian Toys, LLC*, Appeal No. 78916820 (TTAB June 25, 2008) (non-precedential).⁵

Further, both parties offer computer and video game products. Right now, consumers can acquire and play several such products from Opposer, including mobile games Dino Hunt® Dice and Zombie Dice®, mobile apps for use with its board game products, Ogre® War Room and Munchkin® Level Counter, and online games Frag®, Warehouse 23®, and UltraCorps®. 25 TTABVUE 11 (¶ 31). Opposer recently worked with developer Auroch Digital to produce a computer game, Ogre®, based on its classic tank warfare board game. *Id.* at ¶ 32. The game was announced July 26, 2016, and released for purchase on October 5, 2017. *Id.* This game is the second licensed computer game based on Ogre; the first, like Opposer’s AUTODUEL computer game, was released by Origin Systems in the 1980s. *Id.* Opposer is working with developer Asmodee Digital to produce a digital adaptation of its Munchkin® board game as well. The game was announced on October 27, 2017, and planned for release in 2018. *Id.* at ¶ 33.

Video games are indisputably within the zone of natural expansion for the AUTODUEL brand. This fact strongly supports a likelihood of confusion. *See Time Warner Net’mt Co., L.P. v. Jones*, 65 U.S.P.Q.2d 1650, 1662 (TTAB 2002) (“[R]oad maps are within the natural area of expansion of products for which opposer might license use of its Looney Tunes marks, including the Road Runner.”). Where there is evidence that the opposer has actually considered such expansion, this further supports denial of a trademark application. *See R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 U.S.P.Q. 856, 859 (TTAB 1978). Not only has Applicant considered expanding its AUTODUEL Mark to post-apocalyptic vehicle

⁵ A copy of this decision is attached to this brief.

combat games, but has actually licensed the mark for this purpose twice in the past. Applicant cannot credibly argue that the goods at issue here are very closely related.

3. *The Parties' Trade Channels are Identical and/or Overlapping.*

When the subject application does not place specific limitations on the listed goods, it is presumed that the listed goods travel in all “normal and usual channels of trade and methods of distribution.” *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 U.S.P.Q. 198 (Fed. Cir. 1983). Here, because the Application does not limit the trade channels for the listed goods, and because the goods are highly related, the trade channels are considered identical and overlapping. *Id.*

The parties' trade channels are also identical and overlapping in fact. Opposer's mobile games and applications, Dino Hunt® Dice, Zombie Dice®, Ogre® War Room, and Munchkin® Level Counter, are offered or sold through the Apple App Store, the Google Play store, the Microsoft/Windows Phone store. 25 TTABVUE 11-12 (¶¶ 31, 37). Likewise, Applicant plans to offer its AUTODUEL game through the Apple App Store and the Google Play Store. 28 TTABVUE 10 (Ex. 43, Response to Interrogatory No. 12); *see also* 30 TTABVUE 133-34 (Ex. 53 at 66:1-67:23). Opposer's recently-released Ogre® computer game is distributed through the Steam digital distribution platform. 25 TTABVUE 11 (¶ 32). Applicant also intends to offer its proposed AUTODUEL game on the Steam platform. 37 TTABVUE 8 (¶ 25); *see also* 30 TTABVUE 133-34 (Ex. 53 at 66:25-67:17). Opposer's physical game products⁶ are sold at local hobby/game stores, national retail chains (including Target, Wal-Mart, Gamestop, and Walgreens), and a wide range of online retailers (including Amazon.com, Target.com, Walmart.com, online hobby/game stores, and its own Warehouse23.com online retail store). 25 TTABVUE 12 (¶ 35). [REDACTED]

[REDACTED] 30 TTABVUE 134 (Ex. 53 at 67:18-67:23). Simply put, Applicant plans to, or is considering, selling its AUTODUEL game in the same trade channels where Opposer distributes and sells its products.

⁶ For sake of clarity, Opposer's AUTODUEL products are not currently sold in physical formats.

Finally, consumers already encounter Opposer's products and Applicant's products in the same venues. [REDACTED]

[REDACTED] See 25 TTABVUE 12 (¶ 38); 30 TTABVUE 145 (Ex. 53 at 81:1-81:7). Opposer's representatives also appear at industry conventions that are open to the public and attended by companies in both the board game and computer game industry. 25 TTABVUE 12 at ¶ 34. Like the similarity of the goods factor, this factor strongly favors Opposer.

4. Applicant's Mere Filing Has Caused Actual Confusion.

This case presents the rare situation where Applicant's trademark filing resulted in widespread consumer and media confusion prior to any actual use of the mark by Applicant. But given the similarity of the marks, goods, and trade channels, perhaps this should not be a surprise. Opposer learned of Applicant's application to register the AUTODUEL mark after several articles were published on gaming news sites reporting on the discovery of the application. 25 TTABVUE 13 (¶ 39). The confusion started when the account for game news site RPG Codex tweeted on October 22, 2015: "Hell yes" and posted a screenshot of the TSDR page for Applicant's application. See 27 TTABVUE 6 (Ex. 33). The same day, Applicant's CEO, Brian Fargo, responded: "Once again the Codex is the first on the scene..." *Id.* at 8 (Ex. 34). The responses to Fargo's tweet included the following: (1) "@BrianFargo any relation to @SJGames Autoduel?"; (2) "@ryannims @BrianFargo @SJGames Would think so. Another company tried to release an unrelated game and they had to change the name."; and (3) "@mattau with the new edition of Car Wars in progress, now's a great time for a digital version! @BrianFargo @SJGames"; as well as numerous other comments drawing a connection between Applicant's proposed use and the 1985 AUTODUEL game by Origin Systems developed under license from Opposer. *Id.* at 8-10 (Ex. 34).

The exchange between RPG Codex and Applicant's CEO triggered a flurry of articles and consumer comments relating Applicant's proposed use of AUTODUEL on a number of gaming websites. Several of these articles displayed images from Opposer's games (*see, e.g.*, 27 TTABVUE 11-57 (Exs. 35-42), indicating a belief of sponsorship or association between Applicant's application and Opposer and its AUTODUEL mark. See 25 TTABVUE 13, 16, and 121 (¶ 39, and Exs. 6 (AUTODUEL video game

box) and 32 (Car Wars Deluxe Edition box)). Further, many of these articles explicitly stated a belief in sponsorship or association by Opposer or otherwise a connection between Applicant's application and Opposer's AUTODUEL mark, as detailed in the chart below:

<u>Statement</u>	<u>Citation / Source / Author / Date</u>
"Autoduel was a racing/RPG based on the Steve Jackson Games pencil-and-paper RPG Car Wars, a vaguely Mad Max-ish game about heavily-armed vehicles doing battle in a post-apocalyptic America. The computer version was developed by the long-defunct Origin Systems and released all the way back in 1988. And now, if a trademark filing dug up by the RPG Codex is to be believed, it may be on the way back."	27 TTABVUE 12-13, Ex. 35 (SJG000470) PC Gamer Andy Chalk October 22, 2015
"InXile appear to be working on an Autoduel reboot" "The original game . . . was an RPG based around Steve Jackson Games' tabletop title Car Wars." "It looks like the idea for <i>MotorGun</i> has shifted back to inXile, and the rights to use the <i>Autoduel</i> name have been secured."	<i>Id.</i> at 15-16, Ex. 36 (SJG000506-07) PC Invasion Paul Younger October 22, 2015
"A trademark filing spotted by the RPG Codex suggests one possible reason for expansion – another license for another RPG. This time it's Autoduel, the vehicular combat game derived from Steve Jackson Games' Car Wars."	<i>Id.</i> at 20, Ex. 37 (SJG000475) Rock Paper Shotgun Adam Smith October 23, 2015
"InXile Entertainment has filed a trademark for what may be one of their next projects, <i>Autoduel</i> . If it is what they are working on, <i>Autoduel</i> would continue the recent trend from InXile of resurrecting brands from the 1980s and bringing them into the modern day, as the original <i>Autoduel</i> was published in 1985 by Origin as a vehicular combat RPG. Based on the Steve Jackson Games series <i>Car Wars</i> , <i>Autoduel</i> was generally well-received and particularly noted for a punishing difficulty."	<i>Id.</i> at 27, Ex. 38 (SJG000523) Tech Raptor Don Parsons October 23, 2015

Even more confusion can be found in the consumer comments on these and other articles. The chart below reproduces some of the comments from potential consumers:

<u>Comment</u>	<u>Citation</u>
"Very excited to see one of my favorite boardgames getting a PC port by a studio that seems competent. . ."	27 TTABVUE 17 at Ex. 36 (SJG000508)

“The revival of games from the 80s and 90s keeps rolling along. I’m sure that Steve Jackson Games would be thrilled if Fargo and Co can bring Car Wars into the mobile age. . .”	<i>Id.</i> at 23, Ex. 37 (SJG000478)
“If they make Autoduel, it’s a ‘shut up and take my money’ situation for me. I played Car Wars PnP to death, and played Autoduel on the 8-bits nearly to death.”	<i>Id.</i> at 24, Ex. 37 (SJG000479)
“I never played Autoduel, so I have no idea if it’s something worth reviving, but when I hear the phrase “a vehicular combat game, with RPG elements” Steve Jackson’s Car Wars immediately pops into my mind...” “Autoduel was in fact based on Car Wars”	<i>Id.</i> at 33, Ex. 39 (SJG000383)

Consumers posting on Applicant’s own online forums also expressed the belief that Applicant must have Opposer’s permission to use the AUTODUEL mark, *e.g.*, “The original Autoduel was a tabletop RPG and (incredibly complex) turn-based strategy game, so they might be planning to use the license to make a turn-based RPG set in the Autoduel universe.” *Id.* at 44, Ex. 42 (SJG000482).

The extent of actual confusion is amazing, given that Opposer has yet to use the mark in commerce, but it can all be traced back to the RPG Codex tweet and the response by Applicant’s CEO. Notably, Mr. Fargo has made no attempt to correct the misconception that inXile will be rebooting or creating a successor to the 1985 AUTODUEL game. *See* 30 TTABVUE 47-49 (Ex. 52 at 122:22-124:10). This is likely because Mr. Fargo chose the AUTODUEL name at least in part because of its continued association with the 1985 AUTODUEL game licensed by Opposer. *See id.* at 32 (Ex. 52 at 92:10-92:23).

5. *The Parties’ Goods Are Purchased On Impulse.*

Applicant’s proposed goods are mobile phone apps or other computer/video game programs that are purchased on “third party gaming sites such as iTunes and Steam.” 37 TTABVUE 5, 8 (¶¶ 14, 25). Opposer offers a number of mobile phone games and apps that range in price from free to \$4.99. 25 TTABVUE 11 (¶ 31). Such goods can be purchased and downloaded with just a few mouse clicks or screen taps at a low cost. Further, Opposer’s physical AUTODUEL gaming products ranged in price from \$2.50 to \$19.95, and its digital AUTODUEL gaming products range in price from \$2.99 to \$7.99. *Id.* at ¶¶ 31, 24, and Exs. 18-30. “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard

of purchasing care.” *Recot, Inc. v. Becton*, 214 F.3d. 1322, 1329, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). Accordingly, this factor favors Opposer.

6. *Opposer’s AUTODUEL Mark is Longstanding and Well-Known.*

The details of Opposer’s longstanding use of the distinctive AUTODUEL Mark is detailed above in Section IV(A)-(E) and in the Reed Testimonial Declaration at Paragraphs 4-28. Opposer’s thirty-five-plus years of use of the AUTODUEL Mark, especially when viewed in the context of the numerous instances of actual confusion, demonstrate that the AUTODUEL Mark is well-known and enjoys substantial goodwill. For these reasons, this factor favors a finding of likelihood of confusion.

7. *Opposer Uses Its AUTODUEL Mark on a Variety of Goods.*

Use of a mark by an opposer on a variety of products makes it more likely that relevant consumers will be confused by an applicant’s similar mark. *See Uncle Ben’s Inc. v. Stubenberg Int’l Inc.*, 47 U.S.P.Q.2d 1310, 1313 (TTAB 1998). Opposer has used the AUTODUEL Mark for a wide variety of gaming products, including board games, role-playing games, video games, and game supplements and accessories. 25 TTABVUE 3-5 (¶ 8). Opposer has further used the related AADA mark (standing for American Autoduel Association) in connection with patches, shot glasses, and a fan club. *See id.* at Ex. 13. Accordingly, this factor favors Opposer.

8. *The Extent of Potential Confusion Is Substantial.*

The extent of potential confusion is determined by looking at the relatedness of goods and trade channels. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 949 (Fed. Cir. 1998). As discussed above, Applicant’s alleged goods and Opposer’s goods are highly related gaming products to be sold in identical trade channels. The extent of potential confusion is further demonstrated here by the extensive actual confusion, despite Applicant not having even launched a product. Therefore this factor strongly favors Opposer.

9. *Opposer Has Enforced Its Rights in the AUTODUEL Mark.*

In 2013, Opposer sent a demand letter to Big Boat Interactive, Inc./Pixelbionic regarding their proposed use and application to register AUTODUEL for “computer game software for personal

computers and home video game consoles” (Serial No. 85846846). 25 TTABVUE 13 (¶ 40). The application filed by Big Boat Interactive pertained to a computer game announced by the company Pixelbionic, and in response to Opposer’s letter, the name of the proposed game was changed from “Autoduel” to “Motorgun.” *Id.*; *see also* 37 TTABVUE 3 (¶ 6). Pixelbionic’s co-founder, Maxx Kaufman, is a current an employee of inXile Entertainment, Inc., and was working for Applicant at the same time that he was addressing this 2013 dispute. 37 TTABVUE 3 (¶ 6). Ultimately, Opposer filed Opposition No. 91212273 against Big Boat Interactive’s application, and the TTAB sustained the opposition after a default. 25 TTABVUE 13-14 (¶ 41).

Further, Opposer’s enforcement has been successful. Applicant admits that it is not aware of, and has not submitted evidence of, any other uses or registrations by third parties of “Autoduel” in connection with games, toys, computer games, video games, role-playing games, or computer software. 37 TTABVUE 4 (¶ 9).

10. Applicant Chose the AUTODUEL Mark Because of its Goodwill and Was Aware of Opposer’s Claim of Rights Prior to Filing Its Application.

Applicant’s CEO, Mr. Fargo, clearly understands that Applicant’s choice of AUTODUEL carries with it an inherent value as a result of Opposer’s use of the AUTODUEL mark: “Well, I thought it was a great name and I knew there was a computer game before that. So it certainly wouldn’t hurt. . . . Whenever there’s any requisition value for names, I find it helps to establish yourself in a crowded marketplace.” 30 TTABVUE 32 (Ex. 52 at 92:10-92:23). Mr. Fargo went on to admit that his proposed AUTODUEL game would be “based on” Opposer’s prior AUTODUEL game. *Id.* at 70-71 (Ex. 52 at 183:19-184:8). The degree to which Applicant plans to base its proposed AUTODUEL game on Opposer’s intellectual property is not absolutely clear, but what is clear is that Mr. Fargo and inXile believed that in using the AUTODUEL mark, they would receive the benefit of prior goodwill in the mark. That prior goodwill belongs to Opposer.

Mr. Fargo was also aware of Opposer’s prior dispute with Big Boat Interactive/Pixelbionic, and Opposer’s claimed rights in the AUTODUEL mark at least as far back as 2013. *Id.* at 33, 64 (Ex. 52 at

93:20-94:24, 177:1-177:10). After all, Mr. Kaufman, a founder of Pixelbionic, was also working for Applicant at the time Pixelbionic was dealing with Opposer's demand letter and opposition proceeding. 37 TTABVUE 3 (¶ 6).

Applicant had a more-than-sufficient basis to conduct further investigation into Opposer and its AUTODUEL Mark. Instead, Mr. Fargo instructed that Applicant's AUTODUEL application be filed quickly so that no one else could file first. 30 TTABVUE 31-32 (Ex. 52 at 91:17-92:9). Only in the aftermath of filing did Applicant begin considering what type of game it might develop to use with the AUTODUEL mark. *See* Section IV(G). These facts indicate Applicant's bad faith, or at the very least, negate any claim of good faith.

11. Confusion is Likely, and Has Already Occurred.

Based on the foregoing, there should be no doubt that confusion between the two marks at issue is likely. As demonstrated above, every relevant factor favors Opposer's position, many overwhelmingly so. Furthermore, even if some small doubt existed as to confusion, "it must be resolved against the newcomer in favor of the prior user or registrant." *In re Pneumatiques, Caoutchouc Mfr.*, 487 F.2d 918, 919-20 (C.C.P.A. 1972). Accordingly the Board should find that there is a likelihood of confusion and sustain this Opposition.

VIII. CONCLUSION

The record in this case demonstrates that not only is consumer confusion likely if Applicant is permitted to register the AUTODUEL mark in connection with computer and video games, it would be substantial and inevitable. Applicant's registration and resulting use will not only lead to consumer confusion, but also will impair Opposer's long-standing rights in the AUTODUEL Mark. In contrast, Applicant is clearly not far along in its development process and is free to choose a trademark that will not result in consumer confusion. While Applicant may not be able to take advantage of Opposer's goodwill in the AUTODUEL Mark under a different name, it can still produce a computer or video game that stands on its own merits.

For the foregoing reasons, Opposer respectfully requests that the Board sustain the opposition and reject Applicant's Application Serial No. 86702458 to register AUTODUEL.

Respectfully submitted,

Dated: August 13, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S TRIAL BRIEF was served via email to Applicant's counsel of record this 13th day of August 2018.

/Brandon M. Ress/